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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,260	06/25/2003	David Vincent Zyzak	9114ML	4525

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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,260

Applicant(s)

ZYZAK ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 12, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-14 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "reduced", in product/article claims 5 and 12, is a relative term which renders the claims indefinite. The term "reduced" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicant's arguments filed September 12, 2005, have been fully considered but they are not persuasive.

The term "reduced" is a relative term, as are other similar terms such as "less than". As an example, if the instant claim term "reduced" was substituted with the similar term "less than", it would become apparent that an essential part of the phrase is missing. The amount of acrylamide must be less than *something*, i.e. an original amount or an amount present in an otherwise similarly processed composition, save for a particular treatment. As acrylamide is not originally present in the natural starchy foods, the latter must be correct. As previously stated on the record, it is unclear as to why applicant refuses to clarify the claimed invention by not including the phrase which completes the term "reduced".

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It appears that applicant is arguing to make a point, rather than to actually resolve the issue, move the case forward, and consequently, *reduce* the number of rejections present on the record.

At page 3 of the response, applicant's state that "whether one skilled in the art looks to the specification or to common usage, it would be apparent to one skilled in the art that the term 'reduced,' as used in the presently rejected claims, means that the level of asparagine/acrylamide is less in treated food material, i.e., food material not exposed to asparagine-reducing enzymes. Thus, the term 'reduced' means that the food material has been treated such that the level of asparagine/acrylamide is less than what it would be in untreated food material." As previously stated on the record, the definition of the term "reduced" is not in question, and the Examiner agrees with applicant as to the meaning of the term. However, applicant has supplemented the definition of the term "reduced", with context and essential information such that one skilled in the art might recognize and understand the metes and bounds of the claimed invention (i.e. "reduced" from X, or "less than" Y). Again, this essential phrasing does not appear in the claims, and therefore the context of the claims and the term "reduced" is not clear, in light of the specification. While the specification may be useful to clarify or support the claims, it is improper to rely upon the specification to provide the role of distinctly claiming the subject matter which the applicant regards as their invention. The essential conditions must be provided within the context of a claim, in order to establish the necessary properties and in order to understand how the term "reduced" applies in this context. A product, as it stands in its current state, cannot simply be "reduced", without reference to a standard or to the previous condition. Applicants, in their attempt to demonstrate support for the claimed term, even rely upon this fact.

It is noted that in their response, applicant attempted to define the term "reduced" by stating that "the level of asparagine/acrylamide is less in treated food material, i.e., food material not exposed to asparagine-reducing enzymes." However, the instant specification does not appear to be directed toward the use of asparagine-reducing enzymes, nor does it appear to disclose such use. It is not clear whether applicant is unable, or unwilling, to amend the claims in order to clarify the invention according to the 112 2nd paragraph statute; however, it appears that the specification provides sufficient description to do so. Again, applicant is encouraged to accurately describe the invention *within the claims*, as supported by the instant specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

i) Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (US PAT 4,272,554).

Schroeder et al. disclose "blister-inhibited potato chips", which are "inhibited against blister formation during frying". The chips are obtained by added a small amount of calcium, such as calcium chloride, to the potato slices prior to frying. After calcium addition and frying, "the resulting slices are ready for packaging."

It would have been obvious to one of ordinary skill in the art to have packaged and appropriately labeled the potato chips produced by Schroeder et al. Packaging and labeling techniques were well-known and common in the art, especially regarding any potential special feature that might draw the interest of the consumer. Regarding the particular message, it is noted that the printed word itself would not significantly change the claimed article of matter, and would not provide a patentable distinction, *per se*, over the known prior art package materials and methods. Regarding the specific amounts and percentage levels of asparagine and acrylamide in the resultant products of the instant claims, this would have been an inherent result of the natural function of the added calcium and method disclosed. It is important to note that instant product/article claims 5-14 are not limited in their means of production, and may be produced by any number of means, including the addition of cations such as calcium, the addition of asparaginase, or an extraction of asparagine from the food product, each effective in order to inhibit the formation of acrylamide from asparagine, absent any clear and convincing evidence and/or arguments to the contrary. While the reference is silent with regard to the inherent resultant effect of the calcium addition upon acrylamide formation, apart from inhibited blistering after frying, it is noted that the reference need not appreciate every aspect or property of the disclosed invention. This does not detract from the teachings of the reference.

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ii) Claims 5-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Elder et al. (Pub. No. US 2004/0058054). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 12, 2005, have been fully considered but they are not persuasive.

At page 2 of applicant's response, applicant submits the following remarks:

The present application is related and commonly assigned to US Patent Application No. 10/606,137, filed in the name of Zyzak, et al. The Zyzak '137 application claims priority to an application filed on September 20, 2002 while the Elder application claims priority to September 19, 2002. Generally speaking, the subject matter of the present case, the Zyzak '137 application and the Elder application [US Patent App. No. 2004/0058054] relates to the reduction of acrylamide in food products.

On August 22 of this year, a Suggestion of Interference was filed in the Zyzak '137 application over the Elder application. Moreover, the US PTO Private Pair suggests that the prosecution in the Elder application has been suspended, perhaps due to an interference with another application dealing with the reduction of acrylamide in food products.

Regardless, the present application is rejected over the Elder application and commonly owned with the Zyzak '137 application. It is respectfully requested that prosecution in the present application be suspended pending the outcome of the Suggestion of Interference between the Elder and Zyzak '137 application.

This is not deemed persuasive for the reasons of record. Applicant's response to the prior art rejection consists solely of these remarks, and does not address the substance of the rejection.

At this time, the Office will not comment on the status of another application which is not co-owned and related to the current application, and/or possesses a common inventor. Regardless of any potential interference which may or may not eventually occur in any given application, the applicant must overcome all applicable and appropriate rejections, i.e. 35 U.S.C. 112 and prior art rejections, before the current claims may be considered allowable and in condition for further action, be it allowance or interference.

Given applicant's proposed scenario and in response to applicant's comments, applicant is also referred to MPEP section 2303, which states that "an interference should rarely be suggested until examination is completed on all other issues. Each pending claim must be allowed, finally rejected, or canceled." MPEP section 2302 reads:

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Practice 2. Party not in condition for allowance.

When:

- (A) a first application and a second application claim the same patentable invention; and
 - (B) a first application is in condition for allowance; and
 - (C) the second application is not in condition for allowance,
- then generally a notice of allowance should be entered in the first application and it should become a patent.

Without suspending action in the first application and after consultation consistent with Practice 1 above, the examiner may wish to give the second applicant a very brief period of time within which to put the second application in condition for allowance, e.g., by canceling rejected claims thereby leaving only allowable claims which interfere with the claims of the first application.

When examination of the second application is complete, an application versus patent interference may be appropriate.

Practice 3. Both in condition for allowance; earliest effective filing dates within six months.

When two applications are in condition for allowance and the earliest effective filing dates of the applications are within six months of each other, an application versus application interference may be suggested, provided the applicant with the later filing date makes the showing required by 37 CFR 41.202(d). Note that if the earliest filed application is available as a reference (for example, as a published application under 35 U.S.C. 102(e)) against the other application, then a rejection should be made against the other application. Ideally, the rejection would be made early in the prosecution, but if it is not and as a result the junior application is not in condition for allowance, then the senior application should be issued. In light of patent term adjustments it is no longer appropriate to suspend an application on the chance that an interference might ultimately result.

At the time of this Office action, the current application is not in condition for allowance, as all issues have not been resolved.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

i) Claims 5-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of copending Application No. 10/606,260.

ii) Claims 5-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-14 of copending Application No. 10/603,978.

Applicant's arguments filed September 12, 2005, have been fully considered but they are not persuasive. Applicant's comments reflect those presented above, with respect to the prior art rejection. This is not deemed persuasive, and the rejections are maintained for the reasons of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER